



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FLING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/899,434	07/24/97	JOHNSON	J 10172-9013
EXAMINER			
IM31/1026			
ROBERT S BEISER 100 EAST WISCONSIN AVENUE SUITE 3300 MILWAUKEE WI 53202		GRAY, L	PAPER NUMBER
		APT UNIT	
		1734	H
DATE MAILED: 10/26/98			

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on 7-30-98
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 6 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 1-30 & 32-82 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 Claim(s) \_\_\_\_\_ is/are allowed.  
 Claim(s) \_\_\_\_\_ is/are rejected.  
 Claim(s) \_\_\_\_\_ is/are objected to.  
 Claim(s) 1-30 & 32-82 are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
 The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
 The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.  
 The specification is objected to by the Examiner.  
 The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
 All  Some\*  None of the CERTIFIED copies of the priority documents have been

- received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of Reference Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES--

## **DETAILED ACTION**

### **Supplemental Election/Restriction**

1. The election/restriction requirement of 4-28-98 is withdrawn in that some of the claims were groups improperly. The following represents a new election/restriction.

### **Election/Restriction**

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 8-15, drawn to an apparatus for applying fastener tape to a web, classified in class 156, subclass 519.
- II. Claims 4-7 and 34-45, drawn to an apparatus for applying fastener tape to a web and then forming the web into a bag for filling, classified in class 53, subclass 412.
- III. Claims 75-76, drawn to an apparatus for making a tape, classified in class 156, subclass 510.
- IV. Claims 16-19 and 61-71, drawn to a method for applying fastener tape to a web, classified in class 156, subclass 265.
- V. Claims 25-29, drawn to a method for applying fastener tape to a web and then forming the web into a bag for filling, classified in class 53, subclass 412.
- VI. Claims 56-60, drawn to a method for making tape, classified in class 156, subclass 226.
- VII. Claims 45-51, drawn to a method for making a bag, classified in class 53, subclass 459.
- VIII. Claims 30, 32-33, 42-44, and 77-78, drawn to a bag, classified in class 206.
- IX. Claims 36-38 and 80, drawn to a web, classified in class 428.
- X. Claims 39-41, 72-74, and 79, drawn to a tape, classified in class 24.
- XI. Claims 52-55, drawn to a fastener tape, classified in class 24.
- XII. Claims 20-22, drawn to a synchronizing apparatus, classified in class 198.
- XIII. Claims 23-24, drawn to a vacuum belt, classified in class 198.

Note that claims 81 and 82 are not included above because claim 23, from which claim 81 depends, is not a method claim. Also, claim 16, from which claim 82 depends, is not an apparatus claim. Clarification of claims 81 and 82 is suggested such that these claims can be properly placed into one of the above thirteen groups.

3. The inventions are distinct, each from the other because of the following reasons:

(a) Inventions II and I are related as combination and subcombination and Inventions I/II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability and (2) that the subcombination has utility by itself or in other combinations, MPEP § 806.05(c).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because for II-I, the combination II does not require means to tension the tape and the subcombination I has separate utility such as applying fasteners to articles used to make belts or shirts. Also, for I/II-III, the combination I/II does not require means to place the fastener on the tape and the subcombination III has a separate utility such as applying fasteners to belts, shirts, or handbags.

(b) Inventions IV/V/VI/VII and I/II/III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand or (2) the apparatus as claimed can be used to practice another and materially different process, MPEP § 806.05(e).

In this case, the process IV/V/VI/VII as claimed can be practiced by another materially different apparatus such as an apparatus which does not require means to tension the tape (I), a dancer roll (II), and folding means.

(c) Inventions I and VIII/X/XI/XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include an apparatus to make a web with fasteners (I) and a bag (VIII), tape (X), fastener flange (XI), synchronizing apparatus (XII), and vacuum belt (XIII).

(d) Inventions I and IX are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the

apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus, MPEP § 806.05(g).

In this case, the product as claimed can be made by another and materially different apparatus such as an apparatus which does not require a mean to tension the tape.

(e) Inventions II and IX/X/XI/XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include an apparatus to make a web with fasteners into a bag (II) and a web (IX), tape (X), fastener flange (XI), synchronizing apparatus (XII), and vacuum belt (XIII).

(f) Inventions II and VIII are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus, MPEP § 806.05(g).

In this case, the product as claimed can be made by another and materially different apparatus such as an apparatus which does not require a dancer roller.

(g) Inventions III and VIII/IX/XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include an apparatus to make a tape (III) and a bag (VIII), a web (IX), synchronizing apparatus (XII), and vacuum belt (XIII).

(h) Inventions III and X/XI are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1)

that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus, MPEP § 806.05(g).

In this case, the product as claimed can be made by another and materially different apparatus such as an apparatus which does not require a vacuum.

(l) Inventions IV and V are related as combination and subcombination and Inventions IV/V and VI/VII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability and (2) that the subcombination has utility by itself or in other combinations, MPEP § 806.05(c).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because for IV-V, the combination IV does not require vacuum use and the subcombination V has separate utility such as applying fasteners to articles used to make belts or shirts. Also, for IV/V-VI/VII, the combination IV/V does not require means to place the fastener on the tape and the subcombination VI/VII has a separate utility such as applying fasteners to belts, shirts, or handbags.

(j) Inventions IV and VIII/X/XI/XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include method to make a web with fasteners (IV) and a bag (VIII), tape (X), fastener flange (XI), synchronizing apparatus (XII), and vacuum belt (XIII).

(k) Inventions IV and IX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process, MPEP § 806.05(f).

In the instant case, the product as claimed can be made by another and materially different process such as one which uses another form of transport besides a vacuum.

(l) Inventions V and IX/X/XI/XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include an apparatus to make a web with fasteners into a bag (VI) and a web (IX), tape (X), fastener flange (XI), synchronizing apparatus (XII), and vacuum belt (XIII).

(m) Inventions V and VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process, MPEP § 806.05(f).

In the instant case, the product as claimed can be made by another and materially different process such as one which does not bond simultaneously.

(n) Inventions VI and VIII/IX/XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include a method to make a tape (VI) and a bag (VIII), a web (IX), synchronizing apparatus (XII), and vacuum belt (XIII).

(o) Inventions VI and X/XI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process, MPEP § 806.05(f).

In the instant case, the product as claimed can be made by another and materially different process such as a process which folds and then inserts the tape.

(p) Inventions VII and IX/X/XI/XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include a method to make a bag (VII) and a web (IX), tape (X), fastener flange (XI), synchronizing apparatus (XII), and vacuum belt (XIII).

(q) Inventions VII and VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process MPEP § 806.05(f). \

In the instant case, the product as claimed can be made by another and materially different process such as a process which seals simultaneously.

(r) Inventions IX/X/XI and VIII are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph) and the species are patentably distinct (MPEP § 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as a fastener for a belt, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

(s) Inventions VIII and XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different

modes of operation, different functions, or different effects, MPEP § 806.04 and MPEP § 808.01.

In the instant case the different inventions include a bag (VIII) and synchronizing apparatus (XII) and vacuum belt (XIII).

(t) Inventions X/XI and IX are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph) and the species are patentably distinct, MPEP § 806.04(h).

In the instant case, the intermediate product is deemed to be useful as a fastener for a belt, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

(u) Inventions IX and XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04, MPEP § 808.01.

In the instant case the different inventions include a web (IX) and synchronizing apparatus (XII) and vacuum belt (XIII).

(v) Inventions XI and X are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as a fastener for belts and shirt, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

(w) Inventions X and XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04, MPEP § 808.01.

In the instant case the different inventions include a tape (X) and synchronizing apparatus (XII) and vacuum belt (XIII).

(x) Inventions XI and XII/XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04, MPEP § 808.01.

In the instant case the different inventions include a fastener flange (XI) and synchronizing apparatus (XII) and vacuum belt (XIII).

(y) Inventions XII XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, MPEP § 806.04, MPEP § 808.01.

In the instant case the different inventions include a synchronizing apparatus (XII) and vacuum belt (XIII).

4. Because these inventions are distinct for the reasons given above and the search required for one of the Inventions is not required for the other Inventions, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Mr. Levy on 10-23-98 to discuss an oral election to the above restriction requirement, but did not result in an election being made in that the Examiner wished to send a written requirement due to the large number of inventions.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed, 37 CFR 1.143.

### Response to Amendment

7. The amendment filed 7-30-98 has been entered. The amendment did not include items 2-5 (i.e., see Transmittal Letter). It is suggested that these items be included with Applicant's election. With respect to the substitute specification (not yet received), a

statement that the substitute specification does not contain new matter is necessary. The amendment to claim 47, line 9, has not been entered in that "a" is not located on line 9. Applicant is requested to clarify the proposed amendment. The statement on page 9 of the amendment need clarification in that there is no record in the application of a petition denial for entry of photographs.

### Conclusion

8. Any inquiry concerning this communication or earlier communications should be directed to Examiner Linda L. Gray at (703) 308-1093. The fax numbers for this Art Unit are as follows: (703) 305-7718 for official faxes, (703) 305-7115 for unofficial faxes, and (703) 305-3599 for faxes after a final Office action.

llg  
October 23, 1998



David A. Simmons  
Supervisory Patent Examiner  
Technology Center 1700